

REMARKS

Claims 1-33 are pending. Claims 1-33 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1-3, 15-17 and 30-32 under 35 U.S.C. §103(a) as being unpatentable over Distributor Contract. The Examiner has further rejected claims 4-14, 18-29 and 33 under 35 U.S.C. §103(a) as being unpatentable over Distributor Contract in view of Bonneau et al. (U.S. Patent No. 6,978,273) (hereinafter "Bonneau"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Claims 1-3, 15-17 and 30-32 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Distributor Contract.

1. Distributor Contract does not qualify as a prior art reference.

The Distributor Contract is a contractual agreement between Tech Data Corporation and Kofax Image Products where Tech Data Corporation agrees to purchase certain products from Kofax Image Products and where Kofax Image Products agrees to sell certain products to Tech Data Corporation. Independent claims 1, 15 and 30 are directed to a method, system and computer program product, respectively, for implementing commercial interaction between entities in a computerized marketplace. As understood by Applicants, the Examiner is citing Distributor Contract as teaching implementing commercial interaction between entities in a computerized marketplace. However, Distributor Contract is not an enabling disclosure in informing the public as to how to implement the commercial interaction between entities in a computerized marketplace. It is well settled that prior art must sufficiently describe the claimed invention to have placed the public in possession of it. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *In re Sasse*, 207 U.S.P.Q. 107, 111 (C.C.P.A. 1980). Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling.

In re Donohue, 226 U.S.P.Q. at 621; *In re Borst*, 45 U.S.P.Q. 554, 557 (C.C.P.A. 1965), cert. denied, 382 U.S. 973, 148 U.S.P.Q. 771 (1966.) Hence, Distributor Contract does not qualify as a prior art reference. Consequently, claims 1-33 are allowable.

2. Claims 1-3, 15-17 and 30-32 are patentable over Distributor Contract.

Applicants respectfully assert that Distributor Contract does not teach "creating a profile document between a first entity and a second entity containing correspondence information for said second entity; creating a stipulations document associated with said profile document, containing business processes to be followed in said interaction; creating a command reference document associated with said stipulations document, referencing commands representing business logic of said second entity in support of said processes; and integrating said second entity into said marketplace by deploying said profile document in said computerized marketplace to enable said commercial interaction between said first entity and said second entity" as recited in claim 1 and similarly in claims 15 and 30. The Examiner cites to various articles in Distributor Contract as teaching these claim limitations. Office Action (9/11/2007), page 3. Applicants respectfully traverse.

The Examiner has cited to various articles; however, the Examiner has not specifically explained how these articles in a contractual agreement teach creating a profile document between a first entity and a second entity containing correspondence information for the second entity. Neither has the Examiner explained how these articles in Distributor Contract teach the other claim limitations recited above, such as, creating a stipulations document associated with the profile document, etc. There is no language in Distributor Contract that teaches any of the limitations recited above. Therefore, claims 1, 15 and 30 are patentable over Distributor Contract.

Claims 2-3, 16-17 and 31-32 each recite combinations of features of independent claims 1, 15 and 30, respectively, and thus claims 2-3, 16-17 and 31-32 are patentable over Distributor Contract for at least the above-stated reasons that claims 1, 15 and 30, respectively, are patentable over Distributor Contract.

Applicants further assert that Distributor Contract does not teach "wherein said step of integrating further comprises the step of using said information from said profile document, said processes from said stipulations document and said commands referenced by said command reference document" as recited in claim 2 and similarly in claims 16 and 31. As understood by Applicants, the Examiner cites the seven articles in Distributor Contract as teaching the above-cited claim limitations. Office Action (9/11/2007), page 4. Applicants respectfully traverse.

The Examiner has not specifically explained how these articles in a contractual agreement teach that the step of integrating further comprises the step of using the information from the profile document, the processes from the stipulations document and the commands referenced by the command reference document. There is no language in Distributor Contract that teaches the above-cited claim limitation. Therefore, claims 2, 16 and 31 are patentable over the Distributor Contract.

Applicants further assert that Distributor Contract does not teach "wherein said first entity is a manufacturer and said second entity is a distributor" as recited in claim 3 and similarly in claims 17 and 32. As understood by Applicants, the Examiner asserts that Distributor Contract teaches the above-cited claim limitation. Office Action (9/11/2007), page 4. Applicants respectfully traverse.

The Examiner has not provided any evidence to support the assertion that Distributor Contract teaches the above-cited claim limitation. There is no language in Distributor Contract that teaches the above-cited claim limitation. Therefore, claims 3, 17 and 32 are patentable over the Distributor Contract.

3. Examiner has not provided a rational underpinning for modifying Distributor Contract.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient

to defeat patentability of the whole claimed invention. *See Id.* The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

In connection with claims 1, 15 and 30, the Examiner states:

Therefore, it would be obvious, to a person of ordinary skill to agree that all the terms and conditions of the profile, stipulations and the command reference documents which describe and document the business relationship between two entities is functionally identical to the scope and contents of the Distributor Contract. Furthermore, it would be obvious to a person of ordinary skill that a contract authorizes one entity to conduct business in a region, without stipulations limiting how that business will be conducted can be interpreted to mean that the grantee of the Distribution Contract is not precluded from conducting their business over a computerized marketplace and/or "bricks-n-mortar" locations. Office Action (9/11/2007), page 3.

Applicants respectfully traverse. The Examiner makes conclusory statements with no evidence to support such statements. For example, the Examiner concludes that the scope and contents of the Distributor Contract is identical to the profile, stipulations and the command reference documents with no evidentiary support. Further, as understood by Applicants, the Examiner concludes that one of ordinary skill in the art would modify the Distributor Contract to include the aspect of a computerized marketplace with no evidentiary support. The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007). Since the Examiner has not provided such rational underpinning, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 15 and 30. *Id.*

Further, in connection with claims 2-3, 16-17 and 31-32, the Examiner asserts that it would be obvious to modify the Distributor Contract to include these missing claim limitations with no evidentiary support. Office Action (9/11/2007), pages 3-4. As stated above, the Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007). Since the Examiner has not provided such rational underpinning, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-3, 16-17 and 31-32. *Id.*

B. Claims 4-14, 18-29 and 33 are patentable over Distributor Contract in view of Bonneau.

1. Distributor Contract and Bonneau, taken singly or in combination, do not teach at least the following claim limitations.

Applicants respectfully assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "creating a distributor proxy store for said distributor; creating a distributor proxy store default profile document associated with said distributor proxy store; and said distributor proxy store default profile references a profile document for said distributor in a channel store" as recited in claim 4 and similarly in claims 18 and 33. The Examiner cites Figures 1-2 and column 3, lines 1-17 of Bonneau as teaching the above-cited claim limitations. Office Action (9/11/2007), page 4. Applicants respectfully traverse.

Bonneau instead teaches that the method of generating a plurality of custom catalogs from a central database comprising catalog data generally comprises establishing a plurality of rule sets, each of the rule sets expressing constraints that define a subset of the catalog data comprising one of the custom catalogs, each of the rule sets identified by one of a unique set of rule set identifiers, of executing a search of the central database for each of the rule sets in accordance with the constraints expressed by each rule set, each of the searches returning a set of search results

specifying a subset of the catalog data, and of associating each set of rules set search results with the identifier of the rule set used to generate them. Column 3, lines 3-15.

There is no language in the cited passage that teaches creating a distributor proxy store for the distributor. Neither is there any language in the cited passage that teaches creating a distributor proxy store default profile document associated with the distributor proxy store. Neither is there any language in the cited passage that teaches a distributor proxy store default profile that references a profile document for the distributor in a channel store. Therefore, claims 4, 18 and 33 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said referential interface is a command reference object interface implemented by said distributor proxy store" as recited in claim 5 and similarly in claim 19. Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said referential interface command reference document refers to a series of customizable commands representing a business logic implementation of said distributor" as recited in claim 6 and similarly in claim 20. Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said referential interface command reference document specifies authentication and timeout settings for said business logic implementation" as recited in claim 7 and similarly in claim 21. Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said profile document specifies a messaging profile for said distributor" as recited in claim 8 and similarly in claim 22. Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said referential interface has a property of being at least one of customizable and extensible" as recited in claim 9 and similarly in claim 23.

The Examiner cites column 4, lines 36-53; column 5, lines 39-59; column 6, lines 50-67 and column 7, lines 17-37 of Bonneau as teaching the above-cited claim limitations. Office Action (9/11/2007), page 5. Applicants respectfully traverse.

Bonneau instead teaches that a buyer's custom version of the seller's catalog consists of a subset of the items in the catalog database, the scope of which has been predefined for each buyer. Column 4, lines 36-38. Bonneau further teaches that the set of rules defining each custom version of the catalog is maintained independently from the catalog database. Column 5, lines 39-41. Furthermore, Bonneau teaches that an extranet buyer initiates catalog queries through the browser, which are received over Internet 40 by the seller's web server application. Column 6, lines 50-52. Additionally, Bonneau teaches a second mode in which customized catalogs can be provided to is through the process of exportation where exportation of customized catalogs is appropriate when a buyer offers its own catalog of products or services through its own proprietary commercial web site 11. Column 7, lines 17-22.

There is no language in the cited passages that teaches a referential interface that is a command reference object interface implemented by the distributor proxy store. Neither is there any language in the cited passages that teaches a referential interface command reference document that refers to a series of customizable commands representing a business logic implementation of the distributor. Neither is there any language in the cited passages that teaches a referential interface command reference document that specifies authentication. Neither is there any language in the cited passages that teaches a referential interface command reference document that specifies authentication and timeout settings for the business logic implementation. Neither is there any language in the cited passages that teaches a profile document that specifies a messaging profile for the distributor. Neither is there any language in the cited passages that teaches a referential interface that has a property of being at least one of customizable and extensible.

Therefore, claims 5-9 and 19-23 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said profile document is an XML based document" as recited in claim 10 and similarly in claim 25. The Examiner cites

column 7, lines 46-67 of Bonneau as teaching the above-cited claim limitation. Office Action (9/11/2007), page 6. Applicants respectfully traverse.

Bonneau instead teaches that the catalog data comprising the customized subset of the catalog database often must be converted to some format of the buyer's specification prior to exportation. Column 7, lines 48-51. Bonneau further teaches that this could be a fairly standard format such as a version of XML. Column 7, lines 51-52.

There is no language in the cited passage that teaches a profile document that is an XML based document. Therefore, claims 10 and 25 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein manipulation of said referential interface causes an action to be performed for said distributor, said action selected from a group of add distributor, delete distributor and reconfigure distributor" as recited in claim 11 and similarly in claim 26. The Examiner cites column 12, lines 19-44 and Figures 6A-6H of Bonneau as teaching the above-cited claim limitations. Office Action (9/11/2007), page 6. Applicants respectfully traverse.

Bonneau instead teaches that Figures 6A-6H illustrate screen shots produced by the application on a seller-authorized user's web browser by which a rule set is developed for a fictitious extranet buyer or list of buyers called Sellco. Column 12, lines 19-22.

There is no language in the cited passage that teaches that the manipulation of the referential interface causes an action to be performed for the distributor. Neither is there any language in the cited passage that teaches that the manipulation of the referential interface causes an action to be performed for the distributor, the action selected from a group of add distributor, delete distributor and reconfigure distributor. Therefore, claims 11 and 26 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said computer system comprises a node within a plurality of nodes interconnected by a network allowing said first entity and said second entity to be located on differing nodes while interacting over said network" as recited in claim 12 and similarly in claim 27. The Examiner cites column 12, lines 65-67; column 13, lines 1-33 and Figures 1 and 2 of Bonneau as teaching the above-cited claim limitation. Office Action (9/11/2007), page 7. Applicants respectfully traverse.

Bonneau instead teaches that the invention does not have to be implemented using the Internet, but rather may be implemented over any network, using any type of transmission protocol and display formats. Column 13, lines 7-10.

There is no language in the cited passages that teaches a computer system comprising a node within a plurality of nodes interconnected by a network allowing the first entity and the second entity to be located on differing nodes while interacting over the network. Therefore, claims 12 and 27 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein said distributor is one of a plurality of distributors" as recited in claim 13 and similarly in claim 28. The Examiner cites column 1, lines 35-41 and 43-52 of Bonneau as teaching the above-cited claim limitation. Office Action (9/11/2007), page 7. Applicants respectfully traverse.

Bonneau instead teaches that the present invention relates to the field of on-line catalogs, and more particularly to generating customized versions of an on-line catalog for each of an arbitrary number of different buyers, the customized versions being the results of rules-based searches of a central catalog database maintained by the seller. Column 1, lines 36-41. Bonneau further teaches that with the advent of Internet based commerce, organizations on both the buy and sell side of business-to-business (B2B) procurement relationships have sought to harness computer networks as a means for automating the procurement process between them. Column 1, lines 43-47.

There is no language in the cited passages that teaches the distributor is one of a plurality of distributors. Therefore, claims 13 and 28 are patentable over Distributor Contract in view of Bonneau.

Applicants further assert that Distributor Contract and Bonneau, taken singly or in combination, do not teach "wherein each said distributor has its own profile document" as recited in claim 14 and similarly in claims 24 and 29. The Examiner cites column 12, lines 19-44 and Figures 6A-6H of Bonneau as teaching the above-cited claim limitation. Office Action (9/11/2007), page 8. Applicants respectfully traverse.

Bonneau instead teaches that Figures 6A-6H illustrate screen shots produced by the application on a seller-authorized user's web browser by which a rule set is developed for a fictitious extranet buyer or list of buyers called Sellco. Column 12, lines 19-22.

There is no language in the cited passage that teaches that each distributor has its own profile document. Therefore, claims 14, 24 and 29 are patentable over Distributor Contract in view of Bonneau.

2. Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 4, 18 and 33 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner

claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

In order to sustain the rejections of claims 4, 18 and 33 for obviousness, the Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner admits that Distributor Contract does not teach the limitations of claims 4, 18 and 33. Office Action (9/11/2007), page 4. The Examiner asserts that Bonneau teaches the above-cited claim limitations. *Id.* The Examiner's reasoning for modifying Distributor Contract with Bonneau to include the above-cited claim limitations is to "create[s] a complete business solution for a virtual marketplace with distributor proxy stores which can be unique in their look-and-feel and easy to maintain (Bonneau, Column 1, 42-57 and Column 2, lines 1-40)." *Id.* at pages 4-5.

Applicants respectfully contend that the Examiner's reasoning (column 1, lines 42-57 and column 2, line 1-40 of Bonneau) does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Distributor Contract to include the above-indicated missing claim limitations of claims 4, 18 and 33. Bonneau teaches that with the advent of Internet based commerce, organizations on both the buy and sell side of business-to-business (B2B) procurement relationships have sought to harness computer networks as a means for automating the procurement process between them. Column 1, lines 42-47. Bonneau further teaches that although each version of an electronic catalog is maintained by computer, the fact that an update must be performed for each existing version of the catalog can be time-consuming, labor intensive and prone to error. Column 2, lines 20-23. Hence, Bonneau teaches using computer networks for automating the procurement process as well as the fact that updating each existing version of an electronic catalog can be time-consuming, labor intensive and prone to error.

There is no language in Bonneau (and in particular the cited passages) to suggest: (1) creating a distributor proxy store for the distributor; (2) creating a distributor proxy store default profile document associated with the distributor proxy store; and (3) the distributor proxy store default profile references a profile document for the distributor in a channel store (missing claim limitations) in order to create a complete business solution for a virtual marketplace (Examiner's reasoning). In fact, there is no language in the cited passages that suggests creating a complete business solution for a virtual marketplace with distributor proxy stores which can be unique in their look-and-feel and easy to maintain (Examiner's reasoning) as asserted by the Examiner. The Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner's source of reasoning (column 1, lines 42-57 and column 2, lines 1-40) does not provide reasons as to why one skilled in the art would modify Distributor Contract to include the missing claim limitations of claims 4, 18 and 33. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4, 18 and 33. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

3. Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 5-9 and 19-23 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

In order to sustain the rejections of claims 5-9 and 19-23 for obviousness, the Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner admits that Distributor Contract does not teach the claim limitations of claims 5-9 and 19-23. Office Action (9/11/2007), page 5. The Examiner asserts that Bonneau teaches these missing claim limitations. *Id.* The Examiner's reasoning for modifying Distributor Contract with Bonneau to include these missing claim limitations is to "create[s] a complete business solution for a virtual marketplace with distributor proxy stores which can be unique in their look-and-feel and easy to maintain (Bonneau, Column 1, 42-57 and Column 2, lines 1-40)." *Id.*

Applicants respectfully contend that the Examiner's reasoning (column 1, lines 42-57 and column 2, line 1-40 of Bonneau) does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Distributor Contract to include the missing claim limitations of claims 5-9 and 19-23. Bonneau teaches that with the advent of Internet based commerce, organizations on both the buy and sell side of business-to-business (B2B) procurement relationships have sought to harness computer networks as a means for automating the procurement process between them. Column 1, lines 42-47. Bonneau further teaches that although each version of an electronic catalog is maintained by computer, the fact that an update must be performed for each existing version of the catalog can be time-consuming, labor intensive and prone to error. Column 2, lines 20-23. Hence, Bonneau teaches using computer networks for automating the procurement process as well as the fact that updating each existing

version of an electronic catalog can be time-consuming, labor intensive and prone to error.

There is no language in Bonneau (and in particular the cited passages) to suggest: (1) having a referential interface that is a command reference object interface implemented by the distributor proxy store; (2) having a referential interface command reference document that refers to a series of customizable commands representing a business logic implementation of the distributor; (3) having a referential interface command reference document that specifies authentication and timeout settings for the business logic implementation; (4) having a profile document that specifies a messaging profile for the distributor; and (5) having a referential interface that has a property of being at least one of customizable and extensible (missing claim limitations) in order to create a complete business solution for a virtual marketplace (Examiner's reasoning). In fact, there is no language in the cited passages that suggests creating a complete business solution for a virtual marketplace with distributor proxy stores which can be unique in their look-and-feel and easy to maintain (Examiner's reasoning) as asserted by the Examiner. The Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner's source of reasoning (column 1, lines 42-57 and column 2, lines 1-40) does not provide reasons as to why one skilled in the art would modify Distributor Contract to include the missing claim limitations of claims 5-9 and 19-23. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5-9 and 19-23. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

4. Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 10 and 25 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

In order to sustain the rejections of claims 10 and 25 for obviousness, the Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitations. The Examiner admits that Distributor Contract does not teach "wherein said profile document is an XML based document" as recited in claim 10 and similarly in claim 25. Office Action (9/11/2007), page 6. The Examiner asserts that Bonneau teaches the above-cited claim limitations. *Id.* The Examiner's reasoning for modifying Distributor Contract with Bonneau to include the above-cited claim limitations is "as a means of automating the business-to-business (B2B) procurement processes and relationships between two business entities (Bonneau, Column 1, 42-52)." *Id.*

Applicants respectfully contend that the Examiner's reasoning (column 1, lines 42-52 of Bonneau) does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Distributor Contract to include the above-indicated missing claim

limitations of claims 10 and 25. Bonneau teaches that with the advent of Internet based commerce, organizations on both the buy and sell side of business-to-business (B2B) procurement relationships have sought to harness computer networks as a means for automating the procurement process between them. Column 1, lines 42-47. Hence, Bonneau teaches using computer networks for automating the procurement process.

There is no language in Bonneau (and in particular the cited passage) to suggest having a profile document that is an XML based document (missing claim limitation) in order to automate the business-to-business (B2B) procurement process and relationship between two business entities (Examiner's reasoning). The Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and the missing claim limitation. The Examiner's source of reasoning (column 1, lines 42-52) does not provide reasons as to why one skilled in the art would modify Distributor Contract to include the missing claim limitations of claims 10 and 25. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 10 and 25. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

5. Examiner's rationales for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 11, 12, 13, 14, 24, 26, 27, 28 and 29 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness,

the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

In order to sustain the rejections of claims 11-14, 24 and 26-29 for obviousness, the Examiner has to provide some rational connection between the cited passages that is the source of the Examiner's reasoning and these missing claim limitations. The Examiner admits that Distributor Contract does not teach the limitations of claims 11-14, 24 and 26-29. Office Action (9/11/2007), pages 6-8. The Examiner asserts that Bonneau teaches these missing claim limitations. *Id.* The Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 11-12 and 26-27 is to "provide[s] the basis for a solid business solution for business-to-business procurement." Office Action (9/11/2007), pages 6-7. Further, the Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 13 and 28 is to "identify the distribution arrangement results in a contractually sound business-to-business procurement solution." Office Action (9/11/2007), page 7. Additionally, the Examiner's reasoning for modifying Distributor Contract with Bonneau to include the missing claim limitations of claims 14, 24 and 29 is to "provide the distributor implementation details not contained in Distributor Contract." Office Action (9/11/2007), page 8.

The Examiner has not provided any rational underpinning as to how the Examiner derived these motivations for modifying Distributor Contract to include these missing claim limitations. While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Distributor Contract to include these missing

claim limitations. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). The Examiner appears to be relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's rationales for modifying Distributor Contract to include these missing claim limitations of claims 11-14, 24 and 26-29 are insufficient to support a *prima facie* case of obviousness for rejecting claims 11-14, 24 and 26-29. *Id.*

Furthermore, the Examiner has not provided any rational connection between the Examiner's rationales and these missing claim limitations. The Examiner's rationales do not provide reasons as to why one skilled in the art would modify Distributor Contract to include the missing claim limitations of claims 11-14, 24 and 26-29. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 11-14, 24 and 26-29. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited approvingly in *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007)); *Ex parte Hiroshi Yoshizawa et al.*, Appeal No. 2007-3414, p. 6 (Bd. Pat. Inter. October 4, 2007).

II. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-33 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicants

By: _____

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, TX 75201
(512) 370-2832

Austin_1 514790v.2